

REMARKS

Applicants would like to thank the Examiner for the careful consideration given to the present application. The present application currently has claims 20-25 and 31-33 pending. Claims 26-30 have been cancelled. The application has been carefully reviewed in light of the Office Action. Applicants respectfully submit that the claims are patentable over the cited references for at least the reasons set forth below. Reconsideration of this application is hereby requested.

Claim Rejections – 35 U.S.C. 112

The Examiner has rejected claims 25-33 under 35 U.S.C. 112, second paragraph as being indefinite because claim 25 ends with a semicolon rather than a period. Claim 25 has been amended to end in a period instead of a semicolon, which was a typographical error. Claims 26-30 have been cancelled. All of the claims are being presented, with current status identifiers, for the Examiner's ease of reference.

Claim Rejections – 35 U.S.C. 103

The Examiner has rejected claims 20, 24-26 and 30 under 35 U.S.C. 103(a) as being unpatentable over Drew in view of Teter. In light of Applicants cancellation of claims 26-30, it is believed that this rejection, as applied to claims 26 and 30, is moot. With respect to the rejection as applied to claims 20 and 24-25, Applicants traverse this rejection.

In order to establish *prima facie* obviousness of a claimed invention, *all the claim limitations* must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). Additionally, there must be some suggestion or motivation to combine reference teachings. The teaching or suggestion to make the claimed combination as well as a reasonable expectation of success must both be found in the prior art. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner states that Drew discloses a method for comparing colors comprising selecting a color card comprising a surface coated with a layer of a colored coating composition,

and a plurality of perforations that define a chip section, which chip section can be removed to form a window. As the Examiner has noted, Drew fails to teach that the color card can be placed over an item, which can then be viewed through the window. The Examiner further states that Teter discloses a method for comparing colors comprising a color card that is placed over an item so that the item can be viewed through a window in the card. The Examiner states that it would be obvious to modify the method disclosed by Drew by placing the card over the item and viewing the item through the window and that motivation for such method is provided for at Col. 4, lines 58-64 of Drew.

Applicants believe that it is improper to combine the Drew and Teter references. The Examiner cites to motivation that is provided in Drew to place the Drew color card over an item in order to view the item through the window that is created in the Drew color card and that such motivation is provided for in Drew Col.4, lines 58-64. However, the referenced column and line numbers do not appear in the Drew reference. Drew does not contain lines 58-64 in Column 4. Drew does not provide for any suggestion or motivation to place the color card over an item to view the item through the window. In fact, as the Examiner has stated, Drew only contemplates the use of the removable chip sections to serve as a sample to perform color comparisons. Drew expressly provides teaching only for use of the chips to match or compare colors to other items (see Col. 1, lines 21-25). Moreover, Drew inherently teaches away from the use of the color card (with the chip removed) for any purpose whatsoever because the entire focus of the Drew reference and purpose of the Drew reference is directed to the use of the removed chip sections. Drew provides numerous support showing focus on and use of the chip sections themselves – such as means of attachment and removal of the chips, placement of the chip on the color card, and use of the chip with an adhesive backing – however, Drew never addresses the remainder of the color card. The purpose of the Drew reference is to provide for a use for a removable chip and not the remainder of the card from which the chip is detached, therefore, there is no motivation to use the remainder of the card. For these same reasons, there is no motivation to combine Drew with the teachings of Teter to arrive at placing the Drew device over an item to view it through the window.

Furthermore, the express teaching of providing an adhesive backing on the detachable chip section (Col. 2, lines 12-16) provides additional support that the Drew reference is directed to only the use of the chip itself, with the remainder of the color card being nothing more than a

vehicle for providing a detachable chip section. This is further emphasized by noting that the use of adhesive backing is limited to use on the chip section and not the remainder of the card, thereby focusing on the functionality of the chip section itself and not on the remainder of the card. As such, there is no motivation to use the color card by placing the window over an item in order to view the item. Accordingly, there is no motivation to combine the Drew reference with Teter, and vice versa.

Furthermore, although the Examiner notes that Drew does not explicitly discuss the use of its device in conjunction with “commercially available paint colors,” but that such a feature would be an obvious variation on Drew, Applicants do not believe that such a feature is an obvious variation. Although the Drew device may be utilized by an architect or interior designer, it is not obvious to use the Drew device in conjunction with commercially available paint colors. In fact, architects and interior designers would use the Drew device for what it was intended – a presentation for sheet material such as plastic laminates or those materials less brittle than plastic laminates (see Col. 1, lines 3-5 and 11-13, Col. 3, lines 23-26). The Drew reference focuses on use of the device with sheet materials, and not as a general method for matching or comparing colors. The mere possibility that architects and interior designers may work with sheet materials as well as paints does not provide the motivation to extend the use of a device for the display of sheet materials to a method for selecting paint. As importantly, there is no suggestion in the Drew reference (or the Teter reference) to use the Drew device for any purpose other than as a device for viewing sheet materials. Without the suggestion to use the Drew device with paints, there is no motivation to utilize the Drew device in conjunction with paint compositions and such a use cannot be obvious.

With respect to claims 31-33, Applicants also traverse this rejection. The Examiner states that Drew in combination with Teter discloses all of the limits of the claims except the color card having a second surface with a color, but that Edwards provides teaching for placing a color on each side of the card. Applicants do not believe that it would be obvious to combine Drew and Teter with Edwards to include a colored second side. As discussed above, Drew contemplates the use of the color sample to display sheet materials. The Drew color sample is actually made from a single piece of the sheet material itself (Col. 1, lines 15-20). Sheet materials, such as plastic laminates, are not conventionally 2-sided. As such, there would be no

motivation to provide for a 2-sided color sample, and accordingly, no motivation to combine Edwards with Drew and Teter. Moreover, Drew actually provides motivation *not* to have a 2-sided color sample. In Col. 2, lines 12-16 of the Drew reference, it is taught that an adhesive backing can be placed on the chip section surface so that the section can be attached to a specification sheet. It would be impractical and inconsistent to provide for adhesive on the second side of the chip to affix the chip onto another surface and at the same time provide for a colored second side because the second side would never be able to be viewed or used for color comparison. As such, Drew teaches away from providing for a second colored side and cannot properly be combined with Edwards. For at least the foregoing reasons, claims 31-33 are not obvious in light of the cited references.

Additionally, as Applicants have presented above, independent claim 25 is not obvious. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending from the independent claim is also nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). As such, claims 31-33 are not obvious.

Allowable Subject Matter

The Examiner has objected to claims 21-23 as being dependent upon a rejected base claim. Applicants acknowledge and would like to thank the Examiner for stating that claims 21-23 would be allowable if rewritten in independent form. Applicants believe, however, that, in light of the arguments presented above, the independent claim from which claims 21-23 depends is not obvious and should be allowable. As such, claims 21-23 have not been presented in independent form.

Double Patenting

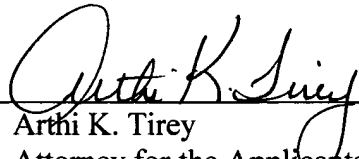
The Examiner has objected to claims 26-29 as being substantial duplicates of claims 20-23. In light of Applicants cancellation of claims 26-30, it is believe that the Examiner's objection has been addressed and the objection is now moot.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If the Examiner has any questions with respect to the foregoing, he is invited to contact the undersigned. Applicants would like to again thank the Examiner for his review of the subject application.

Respectfully submitted,

THE SHERWIN-WILLIAMS COMPANY

By: _____



Arthi K. Tirey
Attorney for the Applicants
Reg. No. 50,960

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The Sherwin-Williams Company
11 Midland Bldg. - Legal Dept.
101 Prospect Avenue, N.W.
Cleveland, Ohio 44115
Phone: (216) 566-3650